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10/071,465	02/08/2002	Laurent Philonenko	P5079	1048
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EXAMINER				
MEINICKE DIAZ, SUSANNA M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/071,465

**Applicant(s)**

PHILONENKO, LAURENT

**Examiner**

Susanna M. Diaz

**Art Unit**

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 12-18 and 30-35 is/are pending in the application.  
4a) Of the above claim(s) 12-17 and 30-35 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 and 18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S5/06)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed February 12, 2008.

Non-elected claims 12-17 and 30-34 stand as withdrawn.

Claims 1 and 18 have been amended.

Claim 35 has been added, but is subject to election by original presentation and is therefore withdrawn.

Claims 2-11 and 19-29 have been cancelled.

Claims 1 and 18 are presented for examination.

2. Newly submitted claim 35 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: This application contains claims directed to the following patentably distinct species:

**Species I:** Directed toward determining a QoS level to be offered to a client based on an expectation of future profit. (Claims 1 and 18)

**Species II:** Directed toward selecting a customer service agent to handle a customer session based on an expected profit contribution from the session.  
(Claim 35)

3. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Currently, no claim is generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 35 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

4. Applicant's arguments filed February 12, 2008 have been fully considered but they are not persuasive.

Applicant argues that "on page 8, lines 25 and 26, it is clearly stated that a 'session host' is an 'entity maintaining one or more communication centers.'" (Page 11 of Applicant's response) Because Iwamura's and Levy's systems "clearly teach network service provider solutions," "it is not accurate to characterize the 'network' of Iwamura (this is what does the deciding in ¶¶ 24-25) as a 'control node of the session host' as recited in claim 1." (Page 11 of Applicant's response) First, it should be noted that the excerpt to which Applicant refers is stated as follows in its entirety, "In a preferred

embodiment the session host is an entity maintaining one or more communication centers." (Page 9, lines 4-5 of the specification) The fact that this definition only applies to the preferred embodiment leaves room for other interpretations of a session host in less preferred embodiments. Second, even though Iwamura's and Levy's networks make decisions, there is a processing element within the network that makes decisions. A network is a broader term, referring to all connections and processing elements that make communications possible within the network. "A control node" may be any point within a network at which certain processing is performing. Looking at the abstract of Iwamura, "A QOS management station consisting of a hub and an exchange in a network sets QOS defined with delay, sensitivity of delay variation, the loss rate of cells, etc., and also determines and manages a corresponding charging system...the charging system based upon transmission capacity units is adopted to charge the quality and quantity of a communication at the same [time]." (Abstract, Solution section) Even based on Applicant's preferred definition of "session host," it is understood that an entity maintains the communication center in base reference Iwamura, such as the general QOS management station. Even if Applicant asserts the entity to be a human, then inherent to Iwamura (which was published in February 20, 1998 and applied for in August 5, 1996) was that the state of the art required that a human somehow implement and/or maintain Iwamura's network and its components.

Applicant argues that Iwamura does not base a judgment to grant a certain QoS based on a transaction history (pages 11-12 of Applicant's response); however, the claimed invention never utilizes the transaction history for any decision-making. As a

matter of fact, the transaction history is currently recited as being solicited, but it is never used to perform any functionality specifically requiring transaction history, thereby rendering it non-functional descriptive material. For example, looking at claim 1, the transaction history is solicited with the client data; however, only the client data is actively compared to stored client data to determine a quality of service option. Consequently, the transaction history will not serve to patentably distinguish the claimed invention over the prior art. Furthermore, the details of the transaction history will be address in the rejections of claims 1 and 18 below.

Applicant argues that the prior art does not address the limitation, "excluding any impact from transport costs"; however, this limitation has raised issues under 35 U.S.C. § 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs. Therefore, Applicant's arguments are currently moot in light of these rejections.

### ***Priority***

5. The validity of the claim of priority to application no. 09/127,284 as a continuation-in-part application is questioned since there is no common inventor. Grigory Shenkman is listed as the sole inventor of parent application no. 09/127,284 and Laurent Philonenko is listed as the sole inventor of the instant application.

Furthermore, the instantly claimed invention is not fully disclosed in the parent application; therefore, the currently presented claims will be granted a priority date of February 8, 2002 (i.e., the filing date of the instant application) for purposes of examination.

*Please correct the claim to priority accordingly since the instant application does not have at least one common inventor with the parent application, which is required to claim Continuation-in-Part status (see MPEP § 201.08).*

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 18 have been amended to recite that at least an expectation of future profit is determined as a result of the session "excluding any impact from transport costs." MPEP 2173.05(i) addresses negative limitations in the claims. Negative limitations are allowed in claims as long as the negative limitations "have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." (MPEP 2173.05(i)) The specification of the instant application does not mention transport costs; therefore, an explicit exclusion of "any impact from transport costs" is not supported by Applicant's disclosure, as originally filed.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 18 have been amended to recite that at least an expectation of future profit is determined as a result of the session "excluding any impact from transport costs." MPEP 2173.05(i) addresses negative limitations in the claims. Negative limitations are allowed in claims as long as the negative limitations "have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." (MPEP 2173.05(i)) The specification of the instant application does not mention transport costs; therefore, the positive metes and bounds that are meant to be gleaned from "any impact from transport costs" are not understood.

Claim 18 recites the step of "matching obtained client data and transaction history data to customer resource management data." Does the matched transaction history data refer to the transaction history data contained in the customer resource management database? This is not clear from the claim. Furthermore, if the matched transaction history data is the same as the transaction history data contained in the customer resource management database, then it is not clear how a match of a certain set of data to itself would yield useful information. On the other hand, if the matched transaction history data is not the same as the transaction history data contained in the

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customer resource management database, then there is no antecedent basis for the "obtained...transaction history data" in step (e) of claim 18.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura (JP 10-51445 A) in view of Levy et al. (U.S. Patent No. 5,291,550), and further in view of Walker et al. (U.S. Patent No. 6,088,444). (A human-machine assisted translation, obtained from the web site of the Japanese Patent Office, has been provided. Additionally, the manual translation is incorporated into the Office action to provide further clarification for the human-machine assisted English translation of Iwamura (JP 10-51445 A), previously provided to Applicant.)

Iwamura discloses a quality of service (QoS) implementation system for a client requesting a communication session with a session host, comprising:

[Claim 1] a control node of the session host connected to the system for receiving a session request from the client and for soliciting client data associated with the request (Detailed Description: ¶ 18 – The user sends a QOS demand to the network);

a data storage system for storing client data (Abstract; ¶ 22; Detailed Description: ¶¶ 24-25 -- History data is stored. Furthermore, a user's conformance with a traffic

agreement is assessed, thereby implying that such a traffic agreement is stored for future reference);

a processor for comparing solicited client data to stored client data and for determining a quality of service option from more than one available option (Detailed Description: ¶¶ 24-25 -- If a user has met the conditions of a traffic agreement, then the demanded QOS is maintained and guaranteed. Otherwise, e.g., if the user has insufficient funds, the demanded QOS is not maintained and/or guaranteed); and

an option execution module for executing the selected quality of service option for application to the session (Detailed Description: ¶¶ 24-25 -- If a user has met the conditions of a traffic agreement, then the demanded QOS is maintained and guaranteed. Otherwise, e.g., if the user has insufficient funds, the demanded QOS is not maintained and/or guaranteed);

characterized in that upon receiving a session request at the control node, the control node solicits data from the request and accesses the data storage system to compare the solicited data with data stored therein and wherein depending on the results of data comparison, determining at least an expectation of future benefit, a QoS level appropriate to the criteria governing the comparison is selected and executed for application to the granted session (Detailed Description: ¶¶ 24-25 -- If a user has met the conditions of a traffic agreement, then the demanded QOS is maintained and guaranteed. Otherwise, e.g., if the user has insufficient funds, the demanded QOS is not maintained and/or guaranteed. A person who has the funds to pay for services rendered and pays accordingly can be interpreted as being a more profitable customer

than someone who does not have the funds to pay for services rendered and therefore cannot pay for such services. The service provider is expected to reap greater benefit from a user who can pay for a granted session as opposed to a user who cannot pay for the granted session, which is why the service provider guarantees better service to the more financially solvent user. Since a determination of expected benefit is only a prediction, there is no requirement that the prediction be 100% accurate; instead, it is a reasonable guess anticipating future behavior, which is an assumption made by Iwamura when deciding which QOS level to maintain and/or guarantee for each user based on the user's financial situation).

Regarding claim 1, Iwamura suggests that the expectation of benefit is profit based (Detailed Description: ¶¶ 24-25 -- If a user has met the conditions of a traffic agreement, then the demanded QOS is maintained and guaranteed. Otherwise, e.g., if the user has insufficient funds, the demanded QOS is not maintained and/or guaranteed. A person who has the funds to pay for services rendered and pays accordingly can be interpreted as being a more profitable customer than someone who does not have the funds to pay for services rendered and therefore cannot pay for such services), yet Iwamura does not expressly disclose that the session request received from the client is a request for an agent of a session host nor that the expected future benefit is determined as a result of the session. However, Levy makes up for these deficiencies in its teachings of a call center in which callers are economically routed to an agent based on various factors, such as if the caller or call center is willing to pay the

extra cost of routing to a remote location or factors regarding the expected profit and cost attributed to the call center's session associated with answering a caller's call (abstract; col. 3, line 46 through col. 4, line 34). As a preliminary note, it should be pointed out that Levy's "customer" is the customer of the call distributor, i.e., Levy's "customer" is contracting services from the call distributor to route calls from its call originators. Levy's routed calls come from call originators. Based on the nature of a call and real-time variables, such as the network load conditions, the expected revenues and costs of a given call are assessed. The analysis of revenues and costs associated with each call yields an understanding of the probable profitability corresponding to each call. Further, the assessment of whether the main purpose of a call is to place an order or receive general information (as taught in the abstract and col. 3, lines 2-3 of Levy) results in a determination of the probable profitability of a call (Levy: abstract). Similarly, Iwamura assesses a quality of service of communication that will be provided and/or guaranteed to users based on each user's ability to pay for the user's desired quality of service (which is suggestive of future profit, since a service provider profits more from paying customers than from customers who fail to pay their bills). As per ¶¶ 24-25 of Iwamura, if a user has met the conditions of a traffic agreement, then the demanded QOS is maintained and guaranteed. Otherwise, e.g., if the user has insufficient funds, the demanded QOS is not maintained and/or guaranteed. A person who has the funds to pay for services rendered and pays accordingly can be interpreted as being a more profitable customer than someone who does not have the funds to pay for services rendered and therefore cannot pay for such services. The service provider

is expected to reap greater profitable benefit from a user who can pay for a granted session as opposed to a user who cannot pay for the granted session, which is why the service provider guarantees better service to the more financially solvent user. Both Iwamura and Levy make business decisions that are expected to economically benefit a service provider and each ultimately renders customer service to its users (based on expected profit) accordingly. Additionally, both Iwamura and Levy attempt to minimize expenses to the service provider by controlling the quality of communication service availed to each user who requests service from the service provider. Levy envisions charging a call center for the receipt of calls via 800 numbers as well as charging for 900 numbers (the charges of which are likely applied to a caller's bill) (col. 3, lines 46-67); therefore, Levy describes a specific environment that would benefit from Iwamura's ability to route communications based on a guaranteed QoS while Iwamura's application to a specific environment would expand the usefulness and marketability of Iwamura's invention. Consequently, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Iwamura to be applied in the area of routing a client to an agent for a communication session such that the session request received from the client is a request for an agent of a session host and the expected future benefit is determined as a result of the session in order to increase the usefulness of Iwamura's invention across various fields (including call center management), thereby making Iwamura's invention more comprehensive and marketable.

As per claim 1, the transaction history is currently recited as being solicited, but it is never used to perform any functionality specifically requiring transaction history, thereby rendering it non-functional descriptive material. For example, the transaction history is solicited with the client data; however, only the client data is actively compared to stored client data to determine a quality of service option. Consequently, the transaction history will not serve to patentably distinguish the claimed invention over the prior art. While Iwamura does not explicitly solicit transaction history, these differences are only found in the non-functional descriptive material and are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106. Nevertheless, Walker tracks customer transaction information and gives his more potentially profitable customers priority in a call center queue based on the customer's transaction history (col. 3, line 64 through col. 4, line 5; col. 6, lines 29-43). According to Walker, giving preferential treatment to

more valued customers "would provide the customer with a sense of reward for his business, and might result in additional future business" (col. 6, lines 41-43). While Iwamura bases his decision of which quality of service to guarantee to a customer on the customer's likelihood of paying for the provided service, Iwamura gives preferential treatment to customers who would generally be considered preferred customers (i.e., customers more likely to fulfill their payment obligations compared to customers who are less likely to make full payment). Iwamura, Levy, and Walker have all devised customer service strategies that center around giving better services (or customer service) to more generally preferred customers. By analyzing a customer's transaction history, Walker clearly shows how a service provider's resources can be more effectively managed by focusing the service provider's customer service resources on customers who are more likely to generate a profit for the service provider. Similarly, Iwamura desires to allocate limited network resources such that customers more likely to pay for the more expensive network services will be guaranteed access to these services; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the Iwamura-Levy combination to solicit transaction history data (e.g., to determine a quality of service to offer to a customer) in order to provide generally preferred customers with a sense of reward for their business, thereby encouraging additional future business (as suggested in col. 6, lines 41-43 of Walker).

Iwamura's determination of future profit is based on some understanding of transport costs; therefore, Iwamura does not explicitly disclose the step of "determining

at least an expectation of future profit as a result of the session *excluding any impact from transport costs.*" However, Levy specifically states that "if the criterion is maximizing profit, then calls of the most profitable type may be given preference for completion, while, during a busy period, some of the less profitable calls are rejected." (Abstract) Levy's expectation of future profit is not based on any impact from transport costs. Both Iwamura and Levy manage their service offerings based on financial considerations; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Iwamura to determine at least an expectation of future profit as a result of the session excluding any impact from transport costs (e.g., based on expected monetary profit) in order to maximize revenue or profit (as suggested in the abstract of Levy).

[Claim 18] Claim 18 recites limitations already addressed by the rejection of claim 1 above; therefore, the same rejection applies.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/  
Primary Examiner, Art Unit 3692